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In the

Supreme Court of the United States

OCTOBER TERM 1964

No. 677

THE GUIBERSON CORPORATION AND DRESSER INDUSTRIES, INC.

Petitioners,

v.

JACK C. WEBBER AND MISSION MANUFACTURING COMPANY,

Respondents.

Petition for Writ of Certiorari to the United States Court of Appeals for The Fifth Circuit and Supporting Brief

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To the Honorable, the Chief Justice, and Associate Justices of the Supreme Court of the United States:

Your Petitioners, The Guiberson Corporation and Dresser Industries, Inc., respectfully pray for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit to review a decision of that Court rendered on July 31, 1964, in the above cause.

A copy of the opinion of that Court is included in the record filed herewith, being reported at 336 F. 2d 461.

In compliance with Rule 23 of this Court the following information, statements and arguments are presented in the order set forth in said Rule:

(a) *Reports of Decisions below:*

The Trial Court opinion is reported at 231 Federal Supplement 596. (Copy is attached; Appendix Page A-1 to 13).

The Court of Appeals opinion is reported at 336 Federal Second Series 461. (Copy is attached; Appendix Page B-1 to B-3).

(b) *Grounds of Jurisdiction:*

(I) The date of judgment of the Appellate Court is July 31, 1964 and the time of entry of the judgment is July 31, 1964.

(II) The date of the order overruling the Petition for Rehearing is September 3, 1964.

(III) The statutory provisions conferring jurisdiction on this Court are as follows:

Title 28, U.S.C.A. Sec. 1254 (1) confers jurisdiction on the Supreme Court of the United States to review decisions of U.S. Courts of Appeals by Writ of Certiorari.

Title 28, U.S.C.A. Sec. 1338 (a) gives U.S. District Courts original jurisdiction in patent infringement cases.

(c) *The questions presented:*

(I) Did the lower courts apply the standard of invention to the patent in suit required of a combination patent as laid down in the case of *Great Atlantic and Pacific Tea*

Company v. Supermarket Equipment Corp., 71 S. Ct. 127; 340 U.S. 147, (1950), and as required in Title 35 U.S.C.A. Sec. 103.

(II) Did the patentee in the patent in suit comply with the provisions of Title 35 U.S.C.A., Sec. 102 (a) (b) (e) (f) and (g) in view of the undisputed evidence.

(III) Did the patentee of the patent in suit comply with the provisions of Title 35 U.S.C.A., Sec. 103, in view of the undisputed evidence.

(IV) Are the claims of the patent in suit sufficiently definite to comply with the provisions of the Statute, Title 35, U.S.C.A., Sec. 112.

(V) Are the findings of fact of the Trial Court, adopted verbatim from Respondents' proposed findings of fact, subject to review by the Supreme Court.

(d) *Constitutional provisions and Statutes involved:*

Constitution of the United States, Art 1, Sec. 8, Cl. 8:

> "Patents and copyrights.—To promote the Progress of Science and useful Arts, by securing for limited Time to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

Title 35, U.S.C.A., Sec. 102:

> "Conditions for patentability; novelty and loss of right to patent
>
> A person shall be entitled to a patent unless —
>
> (a) the invention was known or used by others in this country, or patented or described in a printed

publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or .....

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

Title 35, U.S.C.A., Sec. 103:

"Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Title 35, U.S.C.A., Sec. 112:

"Specification;

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

(e) *Statement of the Case:*

This is a patent infringement suit brought by the Respondents, Jack C. Webber (patentee) and Mission Manufacturing Company (exclusive licensee) against Petitioners for infringement of U.S. Patents 2,633,808 entitled "Well Swab" and 2,719,768 entitled "Well Tools and Sealing Means Therefor" which will be hereinafter referred to as the "808 patent" and "768 patent". (The patents are included in the record, Exhibit Vol. Pages 1 and 2).

The suit was filed on March 10, 1955 and was tried on April 11-20, 1960.

Initial findings of facts and conclusions of law were filed by the Court on March 30, 1961 wherein the Court held both the 808 and 768 patents invalid, based upon prior public use and sales of devices made in accordance with the patents in suit by the Respondents herein (Plaintiffs below).

The Court mistakenly held the 808 patent invalid on such prior use and sales because the prior use and sales were not early enough to predate the filing date of the 808 patent, as stated in the Court of Appeals Opinion.

The case was resubmitted and taken under advisement by the Trial Court for a period of approximately two years. On March 6, 1963 findings of facts and conclusions of law were entered holding Patent 808 valid and infringed, and Patent 768 invalid based upon such prior uses and sales by the Respondents.

Concerning the validity and infringement of the 808 Patent, the Court adopted verbatim the proposed findings of fact numbered I through XI (R. Vol. 5, P. 1226-32) presented by the Plaintiffs below which related to the status of the parties, the patents in suit, jurisdiction, general comments regarding the advantages of swabs made in accordance with patents in suit, the principle of operation thereof, and a general description of prior art devices, finding generally that prior art devices as so classified in Plaintiffs' proposed findings, and as adopted verbatim by the Court, operate on the principle of "the heavier the load, the tighter the seal" whereas the Webber type swabs operate on the

principle of "the heavier the load, the lighter the seal" (Findings of Fact No. 1-11 by Trial Court, Appendix P. A-1 to 8). The Court adopted verbatim Plaintiffs' Findings of fact No. XVII-XIX (Findings of Fact No. 12-14 by the Trial Court, Appendix P. A-8 to 9) (R. Vol. 5, Page 1235-36) relating to infringement anl alleged copying of the commercial form of the swab of the patents in suit. However, the Court omitted Plaintiffs' proposed findings No. XII-XVI (R. Vol. 5, P. 1232-35), relating to proposed specific findings of inapplicability of prior art patents and prior use devices relied on by the defendant, and Plaintiffs' proposed finding No. XXIII (R. Vol. 5, P. 1240) relating to commercial success of the Webber swab.

Thereby there was left a complete hiatus in the findings as to specific applicability of prior art patents and uses to the patents in suit, the Court relying wholly on generalized statements that such prior art patents and devices did not perform the function of the Webber seal.

Final judgment was filed by the Lower Court on April 19, 1963. Appeal to the Court of Appeals for Fifth Circuit was duly perfected, the case was submitted, and the Court of Appeals handed down its decision on July 31, 1964 affirming the decision by the Lower Court en toto. Petition for rehearing was duly filed by Petitioners and was overruled without opinion on September 3, 1964.

(I) The Patents in suit

The patents in suit relate to well swabs, which is a type of plunger lowered on a cable into an oil well below the

fluid therein to remove the fluid. The plunger has rubber cup, or washer-like sealing flanges disposed on the outer side thereof, which engage and seal against the wall of the well pipe, to pull fluid out of the well as the swab is retrieved from the well by pulling upwardly on the cable.

Well swabs of this type have been used for many years prior to the Webber invention.

The alleged improvement made by Webber in the patent in suit was the provision of rubber sealing flanges which are unreinforced, and when subjected to the weight of fluid thereabove, the flanges fold and stretch downwardly in an inverted position to seal against the wall of the well pipe as the swab is pulled upwardly through the pipe, and if subjected to a greater pressure than the rubber flanges can support, the flanges will flex further downwardly to allow the by-pass of the overload of fluid, and will again seal against the wall of the pipe after the overload has by-passed the flanges. The patent is drawn broad enough to cover one such sealing flange or a plurality of sealing flanges molded or otherwise attached to a support which may be disposed on the well swab.

The patent is also broad enough to cover the use of such a rubber sealing flange on any type of well tool, whether used for swabbing or not.

The basic patent No. 808 disclosed rubber sealing flanges which are straight on the edges as is any common flat wash-

er, and thus when inclined upwardly the flanges would be beveled inwardly with relation to the axis of the support on which it was mounted.

It was testified by the expert witnesses for both Plaintiffs and Defendants that such a sealing flange with beveled edges virtually represents a worn out sealing flange and that it would not lift an appreciable amount of fluid from the well (R. Vol. 3, Page 538-42 and Page 622).

To correct this mistake a new patent application was filed which resulted in the 768 patent, wherein the edges of the sealing flanges were made parallel to the axis of the swab support when the flanges were inclined upwardly in order to provide an extra wear surface on the edges of the lips (R. Vol. 2, Page 448).

All swab cups manufactured of the type covered by the patents in suit were made in accordance with the disclosure of the 768 patent.

The Trial Court found, and was sustained by the Court of Appeals, that the 768 patent was invalid by reason of prior use and sales more than one year before the application for patent was filed (R. Vol. 5, Page 1296-1297).

No commercial sale was ever made of the embodiment of the swab cup shown in patent No. 808, now under consideration, and it was apparently discarded as an inoperable device (R. Vol. 1, Page 216).

(f) *Argument:*

1. The Court of Appeals and the District Court failed to apply to the patent in suit the high standard of invention required by the Supreme Court of the United States.

In *Great Atlantic Pacific Tea Co. v. Supermarket Equipment Corp.*, 71 S. Ct. 127; 340 U.S. 147, 1950, it was held that:

> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements."

It was also held in that case that the question of the proper standard of invention to apply to a patent is a question of law and not a question of fact, and that the two Court rule announced in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 336 U.S. 271, 69 S. Ct. 535, is not applicable.

It is Petitioners' contention that the proper standard of invention has not been applied in this case and that, therefore, the Lower Courts have rendered decisions contrary to applicable decisons by the Supreme Court of the United States.

It is without dispute in the record that the novelty claimed for the patent in suit is a sealing element, having a rubber flange or flanges thereon which will fold down in response to pressure exerted thereabove to an inverted position and will fold further downwardly upon being subjected

to a greater pressure to allow fluid to by-pass it. The Trial Court so found. (Finding No. 8, Appendix Page A-6).

The mere statement of the alleged invention in the Trial Courts finding No. 8 should be sufficient to render the patent invalid, because it is obvious without argument that rubber is inherently elastic, and that a rubber flange or washer will bend and stretch in response to pressure exerted thereagainst and will turn "wrong side out" and will dump fluid if sufficient pressure is exerted against it, and no amount of argument can raise this inherent and old function to the dignity of invention.

This alleged invention falls in the category of the ridiculous inventions listed by Justice Douglas in his concurring opinion in *The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.* case, supra, at Page 132.

A higher standard of invention is required than the mere provision of a rubber washer which will turn over in response to pressure, which is the simplest statement of the alleged Webber invention.

Section 103 of the Patent Statute (35 U.S.C.A., Sec. 103), prohibits the patenting of inventions which are obvious at the time the invention is made to a person having ordinary skill in the art to which the subject matter pertains.

It is apparent without argument that the invention claimed in the patent in suit is obvious not only to a person having ordinary skill in the art, but to a five-year old child.

The record is replete with seal members used on well tools and swabs having unreinforced rubber flanges thereon which will turn over to seal against a pipe and will move further downwardly in response to increase of pressure thereabove to by-pass fluid.

These devices begin in 1865 with the Parham patent (Exhibit Vol. P. 175), and include the Westbrook patent, 1877 (Exhibit Vol. P. 180), Jenks patent, 1879 (Exhibit Vol. P. 171), Welter patent, 1895 (Exhibit Vol. P. 179), Rymal patent, 1940 (Exhibit Vol. P. 176), Hamilton patent, 1933 (Exhibit Vol. P. 169), the "Stick Swab" (Exhibit Vol. P. 208, 215, 217-18) used extensively since at least as early as 1921, and the Kobe seal (Exhibit Vol. P. 195-204) which was in public use and on sale in 1947, more than a year before the patent in suit was applied for.

Indeed some of these devices read directly on the specific combination claims of the Webber 808 patent.

For instance, Claim 1, which was one of the representative claims relied on by the Plaintiff in the Trial Court reads directly on the Rymal seal and Claim 15, which was the other representative claim relied on by the Plaintiffs in the Trial Court reads directly on the Stick Swab and the Kobe seal.

All of these prior patents and prior use devices were lightly passed off by the Trial Court in the sterotyped findings presented by the Plaintiffs as being either cup type or plug type sealing elements, which in reality is no distinction at all. No specific finding was made by the Trial Court that

such washer like sealing flanges, shown in the prior art, would not perform the exact function attributed to the Webber invention, or why they would not perform such function. The Court must have realized that to attempt to make such findings would have required stultification. Indeed it was admitted by Plaintiffs' expert witness that the rubber flanges on both the Kobe seal and the Stick Swab would invert and turn downwardly to seal and by-pass fluid (R. Vol. V, P. 1171, 1176-85, 1214).

The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. case, supra, was the last opinion by the Supreme Court of the United States elaborating on the correct standard of invention to apply.

Although the requirement of a high standard of invention was unequivocably announced by the Supreme Court as a matter of law, since the passage of the New Patent Act in 1952 considerable confusion has been evidenced in the decisions of the Courts of Appeal as to whether such high standard of invention is still required or whether Sec. 103 of the New Patent Act abrogated the decision of the Supreme Court in the *A & P* case and set a lower standard of invention.

It is respectfully urged that the instant case presents an opportunity for the Supreme Court to allay and put at rest the confusion existing in the Courts of Appeal and decide once and for all that the standard of invention laid down in the *A & P* case is still effective, and that foolish, insup-

portable patents like the one in suit should not be issued to impose a restriction on the free right of the citizenry and the business of this nation to use that which is rightfully in the public domain.

As examples of the confusion of the Courts of Appeals it has been held by the Second Circuit in *Lyon v. Bausch and Lomb* 224 F. 2d 530, (1955); *Gentzel v. Manning, Maxwell & Moore* 230 F. 2d 41 (1956) and *Riener v. I. Leon Co.*, 285 F. 2d 501 (1960), that Sec. 103 of the New Patent Act of 1952 liberalized the standard of invention laid down by the Supreme Court in the *A & P* case and that the strict standard of invention required therein was no longer applicable.

Other Courts have held that the New Patent Act does not affect or lower the standard of invention. For instance, see *application of O'Keefe*, 202 F. 2d 767 C.C.P.A. (1953) *in re Papesch*, 315 F. 2d 381 C.C.P.A. (1963), *Mojonnier Bros. & Co., Inc. v. Toland Machinery Co., Inc.* 230 F. 2d 850 C.A. 3 (1956), *Griffith Rubber Mills v. Hoffor*, 313 F. 2d 1 C.A. 9 (1963), *Welch Co. of California v. Strolee of Calif., Inc.* 313 F. 2d 923, C.A. 9 (1963).

In *Steffan et al v. Webber Heating & Sheet Metal Co.* 237 F. 2d 601 C.A. 8 (1956) and *Sterling Aluminum Products, Inc. v. Bohn Aluminum and Brass Corp.* 298 F. 2d 538, C.A. 6 (1962) it was held that the high standard of invention required by the Supreme Court is applicable despite the New Patent Act of 1952.

However, it is noted that in *Gibson-Stewart Co. v. Wm. Bros. Boiler Manufacturing Co.*, 264 F. 2d 776 (1959) the 6th Cir., although giving lip service to the high standard of invention required in the *A & P* case, refused to follow said case simply because of the difference in the complexity of the particular devices involved.

In the case of *Heyl & Patterson, Inc. v. McDowell, Inc.*, 317 F. 2d 719, C.A. 4 (1963) the Court held that the question of invention is a constitutional standard as did Justice Douglas in his concurring opinion in the *A & P* case and applied the strict standard of invention required in the *A & P* case.

In another 4th Circuit Opinion, after reviewing the decisions, the Court in *Berry Brothers Corp. v. Sigmon*, 317 F. 2d 700, C.A. 4 (1963) despaired of deciding whether the standard of patentability was the same, or was relaxed by Sec. 103 of the Patent Act of 1952, and in the end adopts the more liberal view of the 2d Circuit, expressed in *Lyon v. Bausch and Lomb* (supra).

Although the Court of Appeals for the Fifth Circuit has heretofore purported to apply the standards of invention pronounced by the Supreme Court in the *A & P* case [*Glitsh v. Wyatt*, 224 F. 2d 331 C.A. 5 (1955)] it certainly departed from this standard in the instant case by the per curiam-like opinion upholding the findings of the Trial Court.

It is respectfully urged that the decision in the instant case is in conflict with the decision of the Supreme Court in the *A & P* case and that certiorari should be granted to settle the question of the effect of Section 103 of the Patent

Act of 1952 on the standard of invention pronounced in the *A & P* case so as to relieve the uncertainty existing in the Courts of Appeal as to the proper standard of invention to apply.

The facts of this case present an excellent opportunity for the Court to settle once and for all this important Constitutional and statutory interpretation question.

2. The alleged novelty set forth in the claims of the patent in suit is presented in functional terms, and distinguished from prior art in terms of function, and therefore the sustaining of said claims by the Lower Courts is contrary to prior decisions by the Supreme Court.

The novelty of the claims of the patent in suit is dependent solely upon statements of function.

Claim 1 of the Webber 808 patent set forth below is an example of the language used in all of the claims:

> "1. A sealing member for a well tool and including,
>
> an elongate tubular body member of resilient material adopted to be mounted on the well tool and having
>
> a plurality of integral spaced resilient annular flange-like sealing rings of substantially uniform cross-sectional thickness projecting outwardly and upwardly from said body in an inverted frusto-conical shape
>
> said sealing rings being each arranged to be flexed downwardly into sealing engagement with the bore wall of the well flow conductor below a horizontal plane for sealing between said conductor and the body member

each sealing ring being arranged to support not more than a predetermined maximum fluid pressure differential

and being each further flexible downwardly out of sealing engagement with the conductor wall upon the application thereto of a fluid pressure differential in excess of said maximum pressure differential carriable by said sealing ring to permit excess fluid pressure to by-pass said ring,

and being arranged to each return to its normal inverted frusto-conical shape when relieved of any pressure differential."

It will be noted that the claim calls for a plurality of spaced resilient annular flange like sealing rings of substantially uniform cross-sectional thickness mounted on a tubular body. This is all of the structure found in the claim.

The rest of the claim beginning with "said sealing rings being each arranged" calls for the function of the sealing rings flexing downwardly to seal against the well flow conductor and flexing further downwardly out of sealing engagement with the conductor wall upon the application of a fluid pressure in excess of the pressure which the sealing flanges can carry.

This of course describes the function of any flexible rubber flange or washer.

In effect, what the patentee claims is any rubber flange-like sealing member which will turn "wrong side out" in response to pressure exerted thereagainst. This describes any and all unreinforced rubber washers and cups known and used since the discovery of the vulcanization of rubber.

Such a claim illustrates the necessity for the rule laid down in *Expanded Metal Co. v. Bradford*, 214 U.S. 36 (1909) wherein it is stated:

> "It is undoubtedly true, and all cases agree, that the mere function or effect of the operation of a machine cannot be the subject matter of a lawful patent."

The reason for the rule is clearly set forth in *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 63 S. Ct. 165 wherein it is stated:

> "* * * The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventors must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not' * * * *"

The patentee, Webber, distinguished his claims over the prior art solely by statements of function, which is improper.

It was stated in *In Re Storsand*, C.C.P.A. (1946) 159 F. 2d 446, 449 as follows:

> "The statements in the claims as to the manner in which the apparatus of appellant operates cannot be properly relied upon to patentably distinguish his structure from that of the Allen Patent. They are functional and cannot be regarded as structural limitations or elements. In re Carr, 120 F. (2d) 386, 28 C.C.P.A. Patents 1240; In re Lamb, 146 F. (2d) 277, 33 C.C.P.A. Patents 799; Gynex Corp., et al v. Dilox

> Institute of Feminine Hygiene, Inc. et al, 2 Cir., 85 F. (2d) 103; General Electric Co. v. Wabash Appliance Corp. et al, 304 U.S. 364, 58 S. Ct. 899, 82 L. Ed. 1402."

In short the statute, 35 U.S.C.A. Sec. 112, and decisions thereunder, require that patents on apparatuses be claimed in terms of structure instead of function or the result thereof, so that the public will be informed as to the metes and bounds of the patent monopoly. See also *McClain v. Ortmayer*, 141 U.S. 419, 424 (1891), *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917), *General Electric Co. v. Wabash*, 304 U.S. 364, 369 (1938).

3. In view of the fact that the Trial Court adopted verbatim the findings of fact submitted by the Plaintiffs' Counsel such findings are subject to review by the Supreme Court.

The Trial Court adopted findings submitted by the Plaintiffs' Counsel relating to the validity of the patent in suit, without change. Therefore, the findings were mechanically adopted by the Trial Court.

In accordance with the holding of the Supreme Court in *United States v. El Paso Natural Gas Co.*, 84 S. Ct. 1044, 1047 (1964) such findings are subject to review by the Supreme Court.

The Court in that case stated:

> "Moreover, these detailed findings were 'mechanically adopted' to use the phrase of the late Judge Frank in United States v. Forness, 2nd Cir. 125 F. (2) 928,942 and do not reveal the discerning line of decision of the basic issue in the case. On review of the record, — which

> is composed largely of undisputed evidence, — we conclude that 'the effect of such acquisition may be substantially to lessen competition within the meaning of the Sec. 7 of the Clayton Act."

The adoption of the "canned" findings in the instant case illustrates the danger of such practice. A patent has been sustained which is ridiculous on its faces, and if it had been examined by the Lower Courts with the care required by the *A & P* case it would have been declared invalid in the Trial Court.

Wherefore, your Petitioner prays the allowance of its foregoing Petition for Writ of Certiorari, for the reasons herein stated.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Two copies of the foregoing Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit and Supporting Brief have been served on Respondents' Counsel by first class air mail, postage prepaid, addressed to Mr. Joe B. Edwards and Mr. Ralph R. Browning at their respective addresses of record on this ..... day of November, A.D., 1964.

Attorney for Petitioners